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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,150	01/13/2004	Viktors Berstis	AUS920030689US1	3337
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER SUAREZ, FELIX E	
			ART UNIT 2857	PAPER NUMBER
			NOTIFICATION DATE 12/15/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/756,150	<b>Applicant(s)</b> BERSTIS ET AL.	
	<b>Examiner</b> FELIX E. SUAREZ	<b>Art Unit</b> 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Withdrawal of Claim Rejections under 35 USC § 101

1. Applicant's request for reconsideration of **35 USC § 101** rejection of the last Office action is persuasive and, therefore, the **35 USC § 101** rejection is withdrawn.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibuya et al. (U.S. Patent Application Publication No. 2004/0064269) in view of Lau et al. (U.S. Patent No. 7,191,435).

With respect to claim 49, Shibuya et al. (hereafter Shibuya) teaches a computer implemented method for creating a new return on investment template from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade, the method comprising;

developing a data list from the plurality of modified templates (see page 8 paragraph [0098], the addition is performed at least once and the result is stored

as a pattern information) and the modified templates effectiveness factors, wherein the data in the modified templates is weighted according to the modified templates' effectiveness factors (see page 5 paragraph [0068], in addition to the automatically created geometric template patterns 705, a user registers a template pattern 707 in advance and a pattern image 706 having the highest matching score selected; and see page 6 paragraph[0080], calculating the matching score between the high density area image 704 and the template pattern image 705, FIG. 15);

plotting (see page 3 paragraph [0052], when a straight line passing through point P1 on the xy space is plotted) the data list on a histogram (see page 5 paragraph [0072], a histogram of the area of the Voronoi cell is calculated), the histogram comprising an orthogonal axis for each parameter in the default template (see FIGS. 6, 7, xy space with orthogonal axis x and y);

analyzing each parameter by performing steps comprising;

determining if the histogram contains more than one peak for a parameter (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked);

responsive to a determination that the histogram contains one-peak, updating a default template parameter value (see page 7 paragraph [0094], the pattern position, size, and shape of the geometric template pattern 705 are roughly classified according to a certain rule and default information is added);

responsive to a determination that the histogram contains more than one peak (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked),

determining if the default template parameter value is within one standard deviation of a first histogram peak (see page 6 paragraph [0085], standard deviation of pixel values inside and outside of the pattern);

responsive to a determination that the default template parameter value is within one standard deviation of the first histogram peak (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern), updating the default template parameter value using a data for the first histogram peak which is within one standard deviation of the default template parameter value (see page 7 paragraph [0094], the pattern position, size, and shape of the geometric template pattern 705 are roughly classified according to a certain rule and default information is added), and analyzing any histogram peak (see page 3 paragraph [0048], the maximum voting value (x, y) is detected as a center candidate. Peak sharpness is checked) that is not within one standard deviation of the default template parameter value (see page 6 paragraph [0085], standard deviation of pixel values outside of the pattern); and

responsive to a determination that the default template parameter value is not within one standard deviation (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern) of any of the histogram peaks, analyzing a second histogram peak (see page 3 paragraph [0048], the maximum

voting value (x, y) is detected as a center candidate. Peak sharpness is checked), and determining if a standard deviation for the second histogram peak is less than a template creation threshold (see page 6 paragraph [0086], the C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern);

responsive to a determination that the standard deviation for the analyzed second histogram peak (see page 6 paragraph [0085], standard deviation of pixel values inside of the pattern) is less than the template creation threshold (see page 6 paragraph [0086], the C is compared to a predetermined threshold value and if the C is equal to or below the threshold value, it is judged that there is no pattern),

Shibuya does not teach;

creating the new return of investment template

But Lau et al. (hereafter Lau) teaches in a method and system for optimizing software upgrades that, the upgrade analysis system 150 preferably further qualifies the at-risk binaries 190 into additional subset that facilitate the determination of whether to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations (see Lau; col. 9, lines 32-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shibuya to include a upgrade analysis system as taught by Lau, because the upgrade analysis system of Lau allows to

proceed with a software upgrade based on return on investment (ROI), as desired.

Shibuya further teaches;

using an average determined by analyzing the second histogram peak (see page 6 paragraph [0084], average value of pixel values inside and outside the pattern);

Shibuya does not teach;

wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer's information technology infrastructure, and whether the customer made purchase.

But Lau teaches that, the upgrade analysis system 150 preferably further qualifies the at-risk binaries 190 into additional subset that facilitate the determination of whether to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations (see Lau; col. 9, lines 32-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Shibuya to include an upgrade analysis system as taught by Lau, because the upgrade analysis system of Lau allows to proceed with a software upgrade based on return on investment (ROI), return on assets (ROA), total cost of ownership (TCO), and other financial and technical considerations, as desired.

***Response to Arguments***

3. Applicant's arguments with respect to the claims have been fully considered but they are moot in view of the new ground(s) of rejection set forth hereinbefore.

4. ***Unpersuasive Argument: Limitation(s) in Preamble***

In response to applicant's arguments, the recitation "from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade" in claim 49 (see Applicant's REMARKS, page 4 of 5 4<sup>th</sup> paragraph), has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). See MPEP ¶ 7.37.10.

In this case the preamble of the independent claim 49 is: "A computer implemented method for creating a new return on investment template from a default template and a plurality of modified templates, the new return on investment template calculating an amount of money a customer will spend for process upgrade"; and the primary applicant's arguments is that Shibuya does not disclose, from a default template and a plurality of modified templates, the



new return on investment template calculating an amount of money a customer will spend for process upgrade; the Examiner notices that the applicant arguments falls entire in the preamble of the claim 49, and the preamble is generally not accorded any patentable weight for a claim.

***Final Rejection***

***Action Is Final, Necessitated by Amendment***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Conclusion***

***Prior Art***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ciccone, Jr. et al. [U.S. Patent No. 6,338,149] describes a managing a plurality of templates.

Nonaka et al. [U.S. Patent No. 6,920,364] describes an analysis for different template portions.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix Suarez, whose telephone number is (571) 272-2223. The examiner can normally be reached on weekdays from 8:30 a.m. to 5:00 p.m.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on (571) 272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and for After Final communications.  
December 4, 2008

/Felix E Suarez/  
Examiner, Art Unit 2857

/Drew A. Dunn/  
Supervisory Patent Examiner  
Art Unit 2863